

REMARKS

The Office Action of October 17, 2006, has been carefully reviewed, and in view of the above amendments and the following remarks, reconsideration and allowance of the pending claims are respectfully requested.

In the above Office Action, claims 1, 3, 4 and 11 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Bayer* (U.S. Published Application No. 2004/0204725), hereinafter *Bayer*, in view of *Agee et al.* (U.S. Patent No. 5,306,284), hereinafter *Agee*. Claims 5-10 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Bayer* in view of *Haber et al.* (U.S. Patent No. ,282,806), hereinafter *Haber*. Claims 12-14 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Bayer* in view of *Agee*.

As set forth above, claims 1 and claim 12 recite that the at least one manipulator fork is extendable through said cone portion.

As previously argued, the primary reference upon which the Examiner relies, *Bayer*, discloses a blunt tip 100 which must be extended and/or rotated relative to the endoscopic barrel in order to permit ligating instrument 132 to access the vessel 210. As such, ligating instrument 132 does not extend through the blunt tip 100. The Examiner relies upon *Agee* for allegedly providing the teaching found lacking in the primary reference. *Agee* discloses a probe 12 having an upper surface 12A and a closed distal end 12B. The distal end 12B is generally rounded. The upper surface 12A includes a lateral aperture 13 adjacent the distal end 12B of the probe. See, col. 3, lines 45-47. A cutting blade 14 is extendable through the lateral aperture 13. Accordingly, as taught by *Agee*, the blade 14 is extendable through the upper surface 12A of the probe 12, i.e., a flat, lateral side surface thereof -- not through a cone portion disposed over a distal end of the barrel, as recited in claims 1 and 12.

Moreover, the distal end of the probe 12 is used to displace the tendons, bursa and median nerve found within the carpal tunnel. Thus, the lateral aperture of the probe is positioned adjacent the medial surface 142 of the flexor retinaculum 128. Col. 7, lines 21-28. At the appropriate location, the blade 14 is extended to contact the distal edge 132 of the flexor retinaculum 128 such that upon withdrawal of the probe 12 the flexor retinaculum 128 is divided and the carpal tunnel is released. As arranged in *Agee*, the distal end portion of the cutting blade 14 follows a path which is essentially **perpendicular** to the longitudinal axis of the probe 12. See, claim 1. In contrast, in *Bayer* as well as in the claimed invention, the manipulator fork must be extended forward, i.e., along the longitudinal axis of the barrel, in order to function properly.

Accordingly, considering the references as a whole, Applicant submits there is no suggestion for the desirability and thus the obviousness of making the combination asserted by the Examiner. Further, without the benefit of impermissible hindsight vision afforded by the claimed invention, Applicant submits there is no motivation to combine the teachings of the cited references, and even if combined, it would not be obvious to one skilled in the art to extend the claimed at least one manipulator fork through a cone portion "disposed over a distal end" of the barrel based upon the teachings for the lateral opening in the upper surface of the probe, as disclosed in *Agee*.

Claim 1 further recites that said cone portion includes at least one fork recess in the distal exterior surface for receiving the at least one manipulator fork when in a retracted position. The presence of the recess in the distal exterior surface of said cone portion allows the cone portion to maintain the contoured profile during

placement and to then utilize the manipulator fork without having to remove the cone portion.

In contrast, and as recognized by the Examiner, *Bayer* does not disclose any type of recess on the distal surface of the blunt tip 100. The closed distal end 12B of *Agee* also does not disclose any type of recess on the distal surface thereof, contrary to the Examiner's assertion. Rather, the upper surface 12A of *Agee* includes a lateral aperture 13, through which a cutting blade 14 is extendable. Applicant respectfully contends that the lateral opening provided in *Agee* for allowing the perpendicular extension and retraction of a cutting blade does not suggest a cone portion including "at least one fork recess in the distal exterior surface for receiving said at least one manipulator fork when in a retracted position such that a contoured profile of the distal exterior surface of said cone portion is maintained." As cautioned by the Federal Circuit, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) Accordingly, Applicant submits claim 1 is not rendered obvious by the applied prior art.

The remaining claims depend upon either claim 1 or claim 12 and are thus patentable over the cited prior art for at least the reasons set forth above.

CONCLUSION

In view of the above amendments and remarks, Applicant respectfully submits that the claims of the present application are now in condition for allowance, and an early indication of the same is earnestly solicited.

Should any questions arise in connection with this application or should the Examiner believe that a telephone conference would be helpful in resolving any remaining issues pertaining to this application; the Examiner is kindly invited to call the undersigned counsel for Applicants regarding the same.

Respectfully submitted,

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